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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|--------------------|
| 10/559,772 | 12/07/2005 | Sergio Santini | 5002-1083 | 5939 |
| 466 | 7590 | 10/21/2010 | EXAMINER | |
| YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314 | | | | GUMBS, KEEGAN ROSS |
| ART UNIT | | PAPER NUMBER | | |
| 3751 | | | | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 10/21/2010 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/559,772 | SANTINI ET AL. | |
| | Examiner | Art Unit | |
| | KEEGAN GUMBS | 3751 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 24 August 2010.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1 and 4-8 is/are pending in the application.

4a) Of the above claim(s) 5 and 7 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1,4,6 and 8 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is dependent on canceled claim 3 and is thus indefinite. Claims 4 and 6 recited the same limitations so the examiner recommends the Applicant cancel claim 6.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claim 1** is rejected under 35 U.S.C. 102(b) as being anticipated by Okamoto et al. (US 5,227,510), hereinafter Okamoto.

Regarding claim 1, Okamoto discloses a ball-point pen comprising;
a tip (2 and 3);
a capillary channel (21 and 23; see Fig. 2) within the tip;
a hole (the hollow interior of element 3; see Fig. 3) within the tip and connected to the capillary channel;

a reservoir (4) communicating with the hole connected to the capillary channel of the tip (2);

a ball (1) for writing, the ball located with the tip;

a cavity (22) which seats the ball (1) for writing, the cavity having a retaining edge (26; see Fig. 2);

a compression-resilient spring (6 and 6a) extending through the hole and terminating in a straight portion (6a), which straight portion is aligned with an longitudinal axis of the ball-point pen, the straight portion having a free end (the tip of 6a) in contact with the ball ,

the ball (1) being kept pressed against the retaining edge (26) of the cavity (22) as a result of the thrust of the compression-resilient spring (6);

a narrow section of a locally radially decreased cross-section within the capillary channel, coming into contact with the said straight portion (6a) of the spring (6), the narrow section preventing the straight portion of the spring from becoming inclined with respect to the longitudinal axis of the ball-point pen (*capillary channel 21 and 23 narrows and at narrow section 23 in Fig. 2, through which the straight part 6a of the spring extends, helping prevent the straight portion from becoming inclined. Portion 5a is in very close contact to the narrow portion shown in Fig. 2. The embodiment showed in Fig. 3 is the same as shown in Fig. 1 and 2 with the portions 5, 51 and 5a in Fig. 1 and 2 being replaced with 6a of Fig. 3*),

the narrow section which, being passed through in the axial direction by the said straight portion (6a) of the spring (6), is dimensioned such as to contain said straight

portion in an approximately complementary manner with a minimum amount of play, substantially preventing said straight portion from assuming inclined positions with respect to the longitudinal axis, and wherein said straight portion (6a) consists of only a single straight portion extending from a distalmost end in contact with the ball (see Fig. 2) towards a coiled portion (6) of the spring, the entire single straight portion being located on the longitudinal axis of the ball-point pen (see Fig. 3); and a radial through-groove (24) connecting the cavity seating the ball to the hole, the radial through-groove being outside the narrow section containing the straight portion (the grooves are radially outside the narrow section).

5. **Claim 1, 4, 6 and 8** are rejected under 35 U.S.C. 102(b) as being anticipated by Fukushima (US 6,220,774 B1), hereinafter Fukushima.

Regarding claim 1, Fukushima discloses a ball-point pen comprising;
a tip (2);
a capillary channel (2g between 2f and 2h; see Fig. 2-4) within the tip;
a hole (the bore of tip 2; see Fig. 2) within the tip and connected to the capillary channel;
a reservoir (5) communicating with the hole connected to the capillary channel of the tip (2);
a ball (3) for writing, the ball located with the tip;
a cavity (the portion of 2 containing the ball 3; see Fig. 3) which seats the ball (3) for writing, the cavity having a retaining edge (2i);

a compression-resilient spring (4) extending through the hole and terminating in a straight portion (4a; see Fig. 2), which straight portion is aligned with an longitudinal axis of the ball-point pen, the straight portion having a free end (the tip of 4a) in contact with the ball ,

the ball (3) being kept pressed against the retaining edge (4i) of the cavity as a result of the thrust of the compression-resilient spring (4);

a narrow section of a locally radially decreased cross-section within the capillary channel, coming into contact with the said straight portion (4a) of the spring (4), the narrow section preventing the straight portion of the spring from becoming inclined with respect to the longitudinal axis of the ball-point pen (*though not labeled with a reference number it is clear that capillary channel 2g has means, where the capillary channel narrows between 2f and 2h of Fig. 2, through which the straight part 4a of the spring extends, helping prevent the straight portion from becoming inclined*),

the narrow section which, being passed through in the axial direction by the said straight portion (4a) of the spring (4), is dimensioned such as to contain said straight portion in an approximately complementary manner with a minimum amount of play, substantially preventing said straight portion from assuming inclined positions with respect to the longitudinal axis, and wherein said straight portion (4a) consists of only a single straight portion extending from a distalmost end in contact with the ball (see Fig. 2) towards a coiled portion (4) of the spring, the entire single straight portion being located on the longitudinal axis of the ball-point pen (see Fig. 2); and

a radial through-groove (2gg; see Fig. 4) connecting the cavity seating the ball to the hole, the radial through-groove being outside the narrow section containing the straight portion (the grooves are radially outside the narrow section).

Regarding claims 4 and 6, Fukushima discloses the narrow section is formed by a cylindrical shaped restriction (see Fig. 4; Fig. 4 is the cross section of the narrow section).

Regarding claim 8, Fukushima discloses a cross section through the narrow section on a plane perpendicular to the longitudinal axis defines a circular opening surrounding said straight portion (see Fig. 4 which is the cross section of the narrow section; 2g defines the circular opening through which the straight portion 4a extends.)

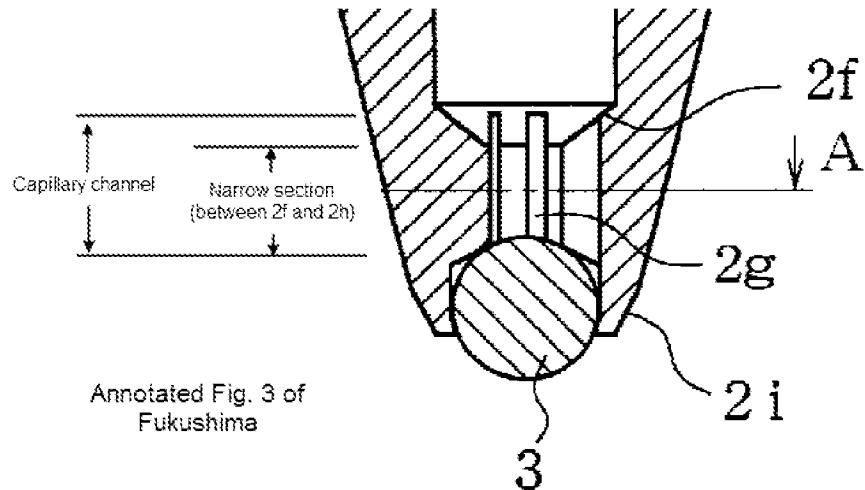
Response to Arguments

6. Applicant's arguments filed 08/24/2010 have been fully considered but they are not persuasive.

On page 11 of the Remarks section, the Applicant has argued that Okamoto does not anticipate claim 1 because the grooves are shown in Fig. 2 and the spring having a straight portion is shown in Fig. 3 and thus because these elements are not shown together they are not part of the same invention. Fig. 3 of Okamoto shows element (2) at the end of writing instrument. Element 2 is the same for every figure of Okamoto and Fig. 2 is simply an enlarged view of the tip of element 2. Furthermore Okamoto discloses "the spring 6 is disposed in holder 3, and the spring 6 has a rod portion 6a formed integrally to extend from one end thereof, which is inserted with the stem 2. Namely, the movable piece 5 is omitted." In other words, the spring 6 with rod

portion 6a is meant to take the place of the movable piece 5 shown in Fig. 1. Therefore Okamoto clearly anticipates all the limitations of claim 1.

On page 12 and 13 of the Remarks section, the Applicant has argued that Fukushima does not disclose a capillary channel having a locally radially decreased cross-section along its longitudinal axis to define a narrow section and that the cross-section of the capillary channel is constant. The examiner disagrees. The examiner clearly disclosed the capillary channel narrows between 2f and 2h of Fig. 2 (see the rejection of claim 1 above). Reference number 2h is not shown in Fig. 3 but is shown to be the bottom edge of 2g in Fig. 2. Since the examiner explained the narrowing portion to be between 2f and 2h, the annotated Fig. 3 below clearly shows cross-section of the capillary channel has narrowing portion between 2f and 2h and therefore Fukushima discloses every limitation of claim 1.



Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEEGAN GUMBS whose telephone number is (571) 270-5608. The examiner can normally be reached on Monday through Friday 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Huson can be reached on (571) 272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. G./
Examiner, Art Unit 3751
October 14, 2010

/David J. Walczak/
Primary Examiner, Art Unit 3751